

REMARKS

I. Status of the Application

Claims 12-23 are all the claims currently pending in the application. Claims 12-17 and 22 have been rejected. Claims 18-21 and 23 have been allowed. The present Amendment addresses each point of rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

II. Double Patenting Rejections

Nonstatutory Double Patenting Rejection Over U.S. Patent No. 6,984,802

Claims 12-17 and 22 stand rejected on the ground of nonstatutory double patenting over claims 1-8 of U.S. Patent No. 6,984,802 to Kuroiwa et al. (hereinafter "Kuroiwa"). The grounds of rejection allege that the claimed subject matter is fully disclosed in Kuroiwa and is covered by Kuroiwa since Kuroiwa and the application are claiming common subject matter. Specifically, the grounds of rejection maintain that Kuroiwa discloses a third polarizing means as recited in claim 12. The grounds of rejection also cite *In re Schneller*, and state that there is no apparent reason why Applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into the Kuroiwa patent. Applicants respectfully traverse these grounds of rejection.

Preliminarily, Applicants note that nonstatutory double patenting rejections based on *Schneller* should be rare, and that the Technology Center (TC) Director must approve any double patenting rejections based on *Schneller*. MPEP § 804(II)(B)(2). Therefore, if the present double

patent rejection is maintained, Applicants respectfully request that the Examiner indicate that such approval was obtained in the next Office Action.

As discussed in the Response filed on January 15, 2008, Kuroiwa does not claim “a third polarizing beam splitter, capable of polarizing- angle adjustment, disposed in front of the first polarizing beam splitter.” Assuming *arguendo* that Kuroiwa discloses the claimed third polarizing beam splitter, Applicants submit that the invention claimed in Kuroiwa is “independent and distinct” from the invention claimed in the present application. MPEP § 804(II)(B)(2).

It may be possible to interpret claim 1 of Kuroiwa as reciting a laser material processing apparatus comprising ABC with the additional limitation “wherein the deflection angle by which said first galvano scanner scans is smaller than the deflection angle by which said second galvano scanner scans” (hereinafter referred to as “X”). Further, it may be possible to interpret claim 12 of the present application as reciting a laser machining apparatus comprising ABCY, where Y is “a third polarizing beam splitter, capable of polarizing- angle adjustment, disposed in front of the first polarizing beam splitter.” However, this situation is different from the facts of *Schneller*, in which X was a separate physical element (an offsetting leg) and Y was a separate physical element (a lip). MPEP § 804(II)(B)(2) states that *Schneller* is limited to its particular set of facts, and does not establish a rule of general application. Therefore, because the X element recited in claim 1 of Kuroiwa is not a physical element, the holding of *Schneller* should not be extended to cover this situation.

Further, none of the claims of Kuroiwa or the present application recite ABCXY, which was claimed in *Schneller* and disclosed as “the greatest advantage and best mode of practicing the invention” (*In re Schneller*, 397 F.2d 350, 355 (C.C.P.A. 1968)). *Schneller* emphasized that the application in *Schneller* sought to patent claims directed to ABCXY. See quotation in MPEP § 804(II)(B)(2). Based *at least* on these differences, Applicants respectfully request that the Examiner withdraw the nonstatutory double patenting rejection of claims 12-17 and 22 over claims 1-8 of Kuroiwa.

Nonstatutory Double Patenting Rejection Over U.S. Application No. 10/432,289

Claims 12-17 and 22 stand provisionally rejected on the ground of nonstatutory double patenting over claims 1-4 of U.S. Application No. 10/432,289 to Ijima et al. (hereinafter “Ijima”). The grounds of rejection allege that the claimed subject matter is fully disclosed in Ijima and would be covered by Ijima since Ijima and the application are claiming common subject matter. Specifically, the grounds of rejection maintain that Ijima discloses a third polarizing means as recited in claim 12. The grounds of rejection also cite *In re Schneller*, and state that there is no apparent reason why Applicants would be prevented from presenting claims corresponding to those of the instant application during prosecution of the Ijima application. Applicants respectfully traverse these grounds of rejection.

Preliminarily, Applicants note that nonstatutory double patenting rejections based on *Schneller* should be rare, and that the Technology Center (TC) Director must approve any double patenting rejections based on *Schneller*. MPEP § 804(II)(B)(2). Therefore, if the present double

patent rejection is maintained, Applicants respectfully request that the Examiner indicate that such approval was obtained in the next Office Action.

Applicants note that the Ijima application was abandoned on June 6, 2005. MPEP § 804(I) states: “A double patenting issue may arise between two or more pending applications, or between one or more pending applications and a patent” (emphasis added). Further, in discussing provisional double patenting rejections between an application and a published application, MPEP § 804(I)(C) states: “Since the published application has not yet issued as a patent, the examiner is permitted to make a ‘provisional’ rejection on the ground of double patenting when the published application has not been abandoned and claims pending therein conflict with claims of the application being examined” (emphasis added). Accordingly, Applicants submit that the double patenting rejection over Ijima is improper, and respectfully request that the Examiner withdraw this rejection.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/524,241

Attorney Docket No.: Q85339

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The U.S.P.T.O. is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: June 25, 2008